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Mailed:
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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Michael Bergman

Serial No. 78114779

D. Clay Holloway of Sutherland Asbill & Brennan LLP for
Michael Bergman.

Andrew J. Benzmilller, Trademark Examining Attorney, Law
Office 116 (Meryl Hershkowitz, Managing Attorney).

Before Hanak, Bucher and Rogers, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Michael Bergman seeks registration on the Principal
Register of the mark WASHINGTON SENATORS for goods
identified in the application, as filed, as "clothing,
namely, t-shirts, shirts, caps, jackets, pants, shorts,
sweatshirts, sweatpants," in International Class 25.¹

This case is now before the Board on appeal from the
final refusal of the Trademark Examining Attorney to
register this designation based upon Section 2(d) of the

¹ Application Serial No. 78114779 was filed on March 14, 2002
based upon applicant's allegation of a *bona fide* intention to use
the mark in commerce. The word "Washington" is disclaimed apart
from the mark as shown.

Trademark Act, 15 U.S.C. §1052(d). The Trademark Examining Attorney has taken the position that applicant's mark, when used in connection with the identified goods, so resembles the mark shown below:



registered for goods identified as "shirts and jackets," also in International Class 25,² as to be likely to cause confusion, to cause mistake or to deceive.

The Trademark Examining Attorney and applicant have fully briefed the case. Applicant did not request an oral hearing before the Board. We affirm the refusal to register.

In arguing for registrability, applicant contends that given the large number of marks on the Principal Register containing the word SENATORS, this is a weak mark when used by itself, and consequently, applicant's addition of the word "Washington" provides the needed distinctiveness to prevent any confusion with the cited mark.

² Registration No. 2494016 issued to Texas Rangers Baseball Partners on October 2, 2001.

By contrast, the Trademark Examining Attorney argues that the involved marks create highly similar commercial impressions; that the goods are identical and otherwise closely-related products; and that applicant has failed to make a showing that the registered mark is entitled to a narrow scope of protection.

Our determination under Section 2(d) is based upon an analysis of all of the facts in evidence that are relevant to the factors bearing upon the issue of likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

We turn first to the relatedness of the goods as listed in the cited registration and in the instant application. Both list "shirts" and "jackets," and the balance of applicant's clothing items appear to be closely related to "shirts and jackets." As is clear from applicant's arguments and from the face of the cited registration owned by a Major League Baseball (MLB) team, these goods are all items of sporting apparel traditionally listed as collateral products for professional sports teams. Moreover, on the specific du Pont factor focusing on the relatedness of the goods, applicant has made

absolutely no attempt to argue that the involved goods are not identical or otherwise closely related.

As to the related du Pont factor focusing on the similarity or dissimilarity of established, likely-to-continue trade channels, we have to presume that these legally identical goods will move through the same channels of trade to the same classes of purchasers.

Applicant does argue that we should pay particular attention to the sophistication of the purchasers herein:

Two marks may exist in the same class of goods and be similar marks where the purchasers of the two products are knowledgeable about the products in that field such to reduce the likelihood of subsequent confusion. See Banfi Products Corp. v. Kendall Jackson Winery Ltd., 74 F.Supp.2d 188, 199 (E.D.N.Y. 1999). Here, Applicant's mark is for goods paying homage to the days gone by of baseball. Applicant places the marks on clothing items as memorabilia relating to that team. One who purchases the clothing on which Applicant places the mark "WASHINGTON SENATORS" would know the difference between that mark and the mark "SENATORS" lacking the "WASHINGTON" component. That difference is one that a purchaser of sports memorabilia, particularly baseball, is likely to know and respect. [Footnote 1: For instance, baseball memorabilia is a phenomenal business market. Moreover, baseball memorabilia fans are notorious sticklers for detail...] As the ultimate consumer of the goods, which the Examiner repeatedly argues gives rise to the likelihood of confusion, is likely to recognize and appreciate the difference between these two marks, the

rejection based on a likelihood of confusion is improper.

Applicant's appeal brief, p. 4. Although the record contains no evidence that the purchasers of registrant's goods are, or purchasers of applicant's listed goods will be, sophisticated consumers, based upon applicant's arguments, we are willing to concede that avid fans of professional sports will know something about the history of baseball in the city of Washington. In fact, as even the casual sports fan knows, although our nation's capital currently has no major league baseball team, two different, defunct American League baseball teams that played here under the name "Washington Senators" have left Washington, the first relocating to Minnesota (becoming the Minnesota Twins in 1960) and the second to Texas (becoming the Texas Rangers in 1971). This latter group is also the owner of the cited registration. Hence, as will be discussed further *infra*, we conclude that any degree of sports knowledge / sophistication imputed to potential purchasers of the involved goods would increase the likelihood of confusion in the instant case, rather than ameliorate it.

The core of applicant's argument is that the cited registration is to be accorded a narrow scope of protection in a crowded field of SENATOR-formative marks. Although

applicant argues repeatedly (response of August 19, 2003, unnumbered pp. 2 - 3, appeal brief, p. 4, reply brief, p. 1) that there are 82 or 83 "listings on the TESS database for marks with 'SENATORS' as a component..." the record does not support such a conclusion. Applicant has included copies of only a handful of the referenced properties, and has not revealed which of the 82 or 83 listings are for active registrations, and which are for dead registrations or merely applications. Significantly, most of the third-party registrations of which applicant has submitted copies for the record actually contain marks where the word SENATOR (singular) is the entire mark, and is registered in connection with totally unrelated goods (e.g., computer manuals for the insurance industry, chairs, mattresses, cigarettes, fishing rods, gas heaters, golf clubs, melons, etc.). Hence, we conclude, based upon this record, that the word SENATORS is distinctive and a strong source identifier for items of apparel.

On the other hand, applicant makes much of two registrations for marks that assertedly are close to the

involved marks -- HARRISBURG SENATORS and design³ and OTTAWA SENATORS.⁴ Both registrations are owned by professional sports teams and are marks for items of apparel in International Class 25. Applicant argues that "if these two marks are distinguishable from themselves, and obviously over "SENATORS" as they are registered, then the Applicant's mark of "WASHINGTON SENATORS" is equally distinguishable." Applicant's reply brief, p. 2.

The record shows that the registration of the OTTAWA SENATORS mark is owned by the Ottawa Senators Hockey Club. Applicant has also submitted for the record a copy of the Internet homepage of the OTTAWA SENATORS. Applicant argues that the coexistence of a registration owned by the OTTAWA SENATORS, a Canadian hockey team and a registration for the stylized mark SENATORS owned by a Major League Baseball team is consistent with yet other third-party registration evidence applicant submitted.⁵

³ Registration No. 1789438 issued on August 24, 1993; Section 8 affidavit accepted and Section 15 affidavit acknowledged, renewed.



⁴ Registration No. 1959122 issued to the Ottawa Senators Hockey Club on February 27, 1996; Section 8 affidavit accepted and Section 15 affidavit acknowledged.

⁵ Applicant points to several situations where similar team names are used in different sports, and/or where two or more

Hence, to the extent that it is relevant to our decision herein, and should we credit applicant's argument that sports fans "are notorious sticklers for detail," we presume sports fans will know that the Ottawa Senators are a Canadian hockey team, while the SENATORS mark in the special form depicted in the cited registration is a commemorative design for a baseball team.

Moreover, while the Harrisburg Senators are a minor league baseball team affiliated with the Montreal Expos, contrary to applicant's argument that "none of these marks [SENATORS, HARRISBURG SENATORS or OTTAWA SENATORS] is owned by the same entity," (applicant's appeal brief, p. 5), the federal register belies applicant's assertion, and demonstrates why at present there may well be no likelihood

sports team names are preceded by different geographic modifiers that allegedly serve to distinguish the marks from each other.

For example, marks such as NEW YORK GIANTS, or the word GIANTS alone, depicted on the side of a football helmet,



can coexist with a registration owned by the San Francisco Giants for the mark GIANTS depicted against the image of a baseball,

and both of these registrations can coexist with a *San Jose Giants* registration, also owned by the San Francisco Giants.

This reality seems to support the conclusion that the word GIANTS depicted on the side of a football helmet in the context of sporting apparel refers to an NFL team in the vicinity of New York City, the word GIANTS depicted against a baseball in the context of sporting apparel refers to a MLB team in San Francisco, while SAN JOSE GIANTS refers to San Francisco's affiliated minor league team in San Jose.

of confusion between the HARRISBURG SENATORS registration and the cited registration -- the HARRISBURG SENATORS registration, like the cited SENATORS registration, is currently owned by the Texas Rangers.

Finally, we turn to the similarity or dissimilarity of the marks in their entirety as to appearance, sound and connotation. We agree with the Trademark Examining Attorney that when, as in this case, the goods in the application and the cited registration are virtually identical, it has been held that the marks need not be as close as they might otherwise have to be to support a finding of likelihood of confusion. Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992), cert. denied, 506 U.S. 1034 (1994).

With respect to a comparison of applicant's typed mark WASHINGTON SENATORS with registrant's special form mark SENATORS, we must consider the marks in their entirety. Nevertheless, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. See In re National Data Corp., 753 F.2d 1056,

224 USPQ 749 (Fed. Cir. 1985). Applicant has agreed to disclaim the geographically descriptive term, "Washington," apart from the mark as shown. Under our precedent, less weight may be accorded to disclaimed matter in making a determination of likelihood of confusion.

We also agree with the Trademark Examining Attorney that with a typed mark, applicant would be free to depict its mark on its clothing items in a script not unlike that used by registrant.

Furthermore, consumers who would notice any actual differences in appearance and pronunciation between applicant's mark, if used, and the cited mark may well not ascribe these differences to differences in the source of the goods. Rather, they may assume that one mark is a variant of the other, each identifying goods coming from the same source. Specifically, in the case of collateral products for a professional sports team, these variations would include the team name, mascot or symbol with and without the name of the host city. That is, a single Major League Baseball team may be referred to as the "Washington Senators" or, at other times, as simply the "Senators."

Applicant's arguments about his motivation for adopting this mark, combined with his allegations about the

knowledge of the potential purchasers, greatly exacerbate the likelihood of confusion herein. Applicant explains his motivations as follows:

Here, Applicant's mark is for goods paying homage to the days gone by of baseball. Applicant places the marks on clothing items as memorabilia relating to that team.

Applicant's appeal brief, p. 4. Applicant also argues that collectors of sports memorabilia have mastered the details of their sports. Applicant argues that "[knowledgeable] sports fans will clearly recognize the 'WASHINGTON SENATORS' mark on clothing as differing from the 'SENATORS' mark which represents nothing. The owners of the 'SENATORS' mark do not have a sports franchise operating under that name... [I]t is likely that [the knowledgeable] sports fan will recognize the difference between the 'WASHINGTON SENATORS,' a team that is no more, and the 'SENATORS,' a team that never existed." Of course, beyond not comporting with trademark law, applicant's conclusions defy logic and ignore history. Applicant admits that he intends to appropriate the WASHINGTON SENATORS mark in order to trade on the nostalgia of bygone baseball teams that existed in Washington DC. On the other hand, he contends that knowledgeable sports fans would never associate the term WASHINGTON SENATORS with the term

SENATORS presented in a distinctive baseball lettering script and emblazoned across the front of jerseys and jackets. This position seems incredible, especially in light of the fact that the cited registration is owned by the very franchise that once was an expansion team in Washington, known as the Washington Senators, and the cited registration of the SENATORS mark would appear to be similarly evocative of the franchise's earlier incarnation. Given this particular history, even more than would be the case under black-letter trademark law and traditional likelihood of confusion analysis, we have no doubts whatsoever but that the respective marks, WASHINGTON SENATORS and SENATORS, are sufficiently similar as to result in a likelihood of confusion when used on these identical products.

Decision: The refusal to register under Section 2(d) of the Lanham Act is hereby affirmed.